

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

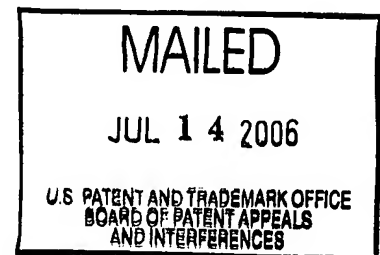
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL WAYNE BROWN, MARK JOSEPH HAMZY and SCOTT THOMAS
JONES

Appeal No. 2006-1790
Application No. 10/042,030

ON BRIEF



Before, THOMAS, KRASS, HOMERE, **Administrative Patent Judges.**
KRASS, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-5, 11-17, and 22-25.

The invention pertains to enhancing the visibility of documents. When a document is viewed on a viewer such as a Web browser, a clarification tool is provided for modifying the attributes of the document to make the text more visible. User preferences define the manner in which the document attributes are modified. Such user preferences include, for example, background color or text color.

Representative independent claim 1 is reproduced as follows:

1. A method for clarifying a document, comprising:

retrieving a document including a document component having an attribute, wherein the attribute is explicitly specified in the document;

displaying the document;

loading a set of user preferences; and

in response to activation of a clarification control, modifying the attribute to clarify display of the document based on the set of user preferences to form a clarified document.

The examiner relies on the following reference:

Internet Explorer 5 (IE) released 1998.

Additionally, the examiner relies on admitted prior art (APA), at pages 1-2 of the instant specification and on a "conventional computer system."

Claims 1-5, 11-17, and 22-25 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers APA in view of IE with regard to claims 1-5, 11-17, 22, 23, and 25, while relying on a "conventional computer system" (answer-page 10) in view of IE with regard to claim 24.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071,

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be

solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, __ F.3d__, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR §41.37(c)(1)(vii) (2004)].

Focusing on claim 1, the examiner asserts that page 2 (page 1?), lines 13-17, of the instant specification describes a conventional system wherein the clarification of a document is admitted as being well known, and that lines 22-25, on that page

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of the instant specification, describe the conventional retrieval of a document by a browser. Moreover, the examiner points to page 1, lines 17-21, of the instant specification as evidence of a conventional document component having an attribute, such as font size and color.

The examiner admits that the conventional systems described in the instant specification do not describe the claimed step of "loading a set of user preferences" and "in response to activation of a clarification control, modifying the attribute to clarify display of the document based on the set of user preferences to form a clarified document."

The examiner turns to IE to show that a user was allowed to define user preferences for attributes of a document by selecting Tools-Internet Options, and then selecting Accessibility-Colors-Fonts. Thus, according to the examiner, a set of user preferences is loaded by IE by selecting three boxes in Accessibility to ignore the explicitly specified background color, font style, font size of the retrieved web page, and then specifying the user preference for background color, font style and font size (see pages 5-7 of the answer).

The examiner asserts that after specifying the user preference, the "OK" box is selected as a "clarification control" and after the selection of the "OK" box, the attributes of the document are modified to clarify the display according to the

user preference attribute. These actions, contend the examiner, constitute the claimed "in response to activation of a clarification control, modifying the attribute to clarify display of the document based on the set of user preferences to form a clarified document."

The examiner concludes that it would have been obvious to use the properties of IE to modify the color of text and background in order to improve the view of a document, as claimed.

Appellants take a different view. Appellants concede that Web pages existed, prior to the invention, that included background images, background colors, and text colors. They do not concede, however, that recognition of the problem associated with background images, background colors, and text colors existed in the prior art (page 10 of the principal brief). If that problem was known, they argue that the manner in which they solved the problem did not exist in the prior art.

Appellants argue that "no method, apparatus, or computer program product in the prior art, admitted or otherwise, clarifies a document based on a set of loaded user preferences responsive to selection of a clarification control" (page 10-principal brief).

Appellants note that IE permits the configuration, by a user, of background colors, text colors, and link colors, but

contends that this feature is a graphical user interface (GUI) for allowing the user to set preferences for the Web browser, but once changes are made to the configurations and the user selects "OK," the preferences are set and these settings are always applied to Web pages when IE displays those Web pages.

Appellants compare this with the present invention which clarifies a document in response to activation of a clarification control, so that a document is retrieved and presented and, in response to activation of a clarification control, the presently claimed invention modifies an attribute of a component of the Web page to clarify the display of the document based on the set of user preferences, rather than applying preferences for all documents.

We have reviewed the evidence before us, including, inter alia, the arguments of appellants and the examiner and we conclude therefrom that the examiner has established a prima facie case of obviousness that has not been successfully rebutted by appellants.

While we understand the differences between appellants' disclosed invention and that disclosed by APA and IE, we do not find that the instant invention, as claimed distinguishes over the applied prior art. We understand that IE allows a user to change the defaults of attributes, such as fonts and colors, of downloaded web documents, whereas appellants' invention allows

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the user to change, or clarify, a specific document, after it is received and displayed. However, consider the operation of IE vis a vis the instant claim language, e.g., claim 1:

When a document is received in IE, it includes a document component having an attribute (e.g., background color). This attribute is "explicitly specified in the document because the user viewing the document can see that attribute. Once downloaded, or received, the document in IE is displayed. Now, in IE, the user has no clarification controls on the specific displayed document. However, the user can go to "Tools-Internet Options," etc, as noted by the examiner, and change the default settings so that the next time that particular document is downloaded, or received, it will, indeed, have the new attributes set by the user. Thus, in IE, after the document is displayed, the user goes to Tools, etc, to "load a set of user preferences," and then, in response to an activation of a clarification control (Tools, etc), the attribute is modified to clarify the display of the document based on the set of user preferences to form the clarified document (i.e., the new settings by the user will "clarify" the document in accordance with the user's preferences, so that the next time any document, including that same document, is received, it will have the clarification set in accordance with the user's preferences).

It is true that the user, in IE, cannot look at a received document and, right before his/her eyes on the display, activate a control and see an immediate change in attributes. But, the claims do not require such. Claim 1, for example, requires the receipt of a document. Both APA and IE perform that step. The document must then be displayed. Again, both APA and IE will display the document on the Web browser. The claim then requires a loading of a set of user preferences. IE permits this, albeit not immediately while viewing the received document. Instead, in IE, the user accesses, and changes the default settings by clicking on the appropriate buttons (Tools, etc.), but this is not precluded by the instant claim language. The loading of the user preferences must follow the display of the document according to the claim language, and, as explained supra, this is exactly how IE may be operated. Finally, in response to activating a clarification control, the attribute is modified to clarify display of the document based on the user preferences. In IE, in response to activating the proper buttons (Tool, etc.), i.e., a "clarification control," an attribute (e.g., background color) is modified by the user so that when the received document is received again, the new default settings by the user will cause the document attributes to be in accordance with the user preferences.

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Therefore, we will sustain the rejection of claim 1, and of claims 2, 4, 5-10, 12-14, and 16-21, which are argued together with claim 1 (see pages 10-12 of the principal brief) under 35 U.S.C. §103.

Turning to claims 3 and 15, these claims require that the document component comprise a background color and the step of modifying the attribute comprises removing the background image from the document.

The examiner identifies APA, page 2, lines 6-9, as teaching that the document component may comprise a background image, and IE as selecting a box to ignore the color specified on Web pages, thus removing a background image from the document, as claimed.

Appellants argue that a background color, removable in IE, is not the same as a background image. We disagree. A broad, but fair, interpretation of a background image would also comprise the background color as this defines the "image" of the background. The background "image" being totally blue is a different "image" than the background image being totally white, for example.

Thus, we will sustain the rejection of claims 3 and 15 under 35 U.S.C. §103.

With regard to claims 11 and 22, these claims include an authentication of the user, wherein the step of modifying the

attribute comprises modifying the attribute in response to the user being authenticated.

The examiner contends that both APA and IE authenticate a user, and that after authentication, when the user modifies an attribute, this modification is "in response" to the user being authenticated.

While appellants do not deny that conventional systems authenticate users, appellants argue that IE does not provide any connection whatsoever between user identification and accessibility options.

Again, while we understand the differences between the disclosed invention and that described by IE and what was conventional in the art, we do not find that the instant claim language distinguishes over the prior art. That is, while appellants wish the attribute modification to be a direct result of user authentication (so that a user signing on will automatically be sent documents in accordance with that user's preferences), the claims only require that the modifying step be "in response to the user being authenticated." A broad, yet reasonable interpretation, in our view, would be that although the prior art does not *automatically* modify the attribute on authenticating the user, the modification is certainly "in response to the user being authenticated" since until the user is authenticated, he/she cannot have access to the system in order

to change the default settings of the Web page attributes. Thus, being given access (being authenticated) permits the user to modify the attributes. Therefore, in the prior art, the attribute is modified "in response to the user being authenticated," even though we realize this is not what is intended by appellants. Still, the claim language must be given its broadest, yet reasonable, interpretation. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of the claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969). "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

Accordingly, we will sustain the rejection of claims 11 and 22 under 35 U.S.C. §103.

With regard to claim 24, the examiner explains, at pages 10-13 of the answer, why it would have been obvious to modify a conventional computer using a Windows 98 operating system with the features of IE, version 5.0 in order to retrieve a document

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from the Internet and enhance the view of the document corresponding to user preferences. The examiner's rationale appears reasonable to us and we adopt the reasoning therein.

Appellants argue that while the prior art ignores particular attributes of a document for *all* documents presented by the browser, the instant invention permits only the received document to be modified.

Again, for the reasons *supra*, with regard to claim 1, we find that appellants' interpretation is too limiting and that even though the prior art would require the user to change the settings for *all* documents subsequently received, the changed setting will certainly cause the document of interest to be modified in accordance with the user's preferences the next time that document is received and this is not seen to be precluded by the instant claim language.

Accordingly, we will sustain the rejection of claim 24 under 35 U.S.C. §103.

Since we have sustained all of the rejections of claims 1-5, 7-11, and 22-25 under 35 U.S.C. §103, the examiner's decision is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

Jean R. Homere
JEAN R. HOMERE
Administrative Patent Judge

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